

REMARKS

In the Office Action, the Examiner rejected claims 19, 21-27, 30, 40, 42, and 43. Further, the Examiner objected to claims 28, 29, 31, and 32 for depending from a rejected base claim, but indicated that these claims each contain allowable subject matter. The Examiner also allowed claims 1, 2, 4-18, 33, and 35-39. Applicants canceled claims 3, 20, 34, 41, and 44-50 in a previous communication. Applicants would like to thank the Examiner for the recognition of allowable subject matter in the present claims. However, for the reasons set forth below, Applicants respectfully submit that all of the pending claims are allowable in their present form. Applicants respectfully request reconsideration of the above-referenced application in view of the following remarks.

Rejections Under 35 U.S.C. § 112

The Examiner rejected claim 42 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Particularly, the Examiner objected to the use of the term “pattern” in the claim. Applicants respectfully traverse this rejection.

Although the Examiner may take exception to the terms used in the claims, he is reminded that the patentee may be his own lexicographer. *Ellipse Corp. v. Ford Motor Co.*, 171 U.S.P.Q. 513 (7th Cir. 1971), *aff’d*. 613 F.2d 775 (7th Cir. 1979), *cert. denied*, 446 U.S. 939 (1980). The terms employed in the claims are clearly described in the specification, which provides adequate teaching for one skilled in the art to make and use the claimed invention.

Further, a claim satisfies 35 U.S.C. § 112, second paragraph, if the claim apprises one of ordinary skill in the art of its scope, thus providing clear warning to others as to what constitutes infringement of the patent. *See Solomon v. Kimberly-Clark Corp.*, 55 U.S.P.Q.2d 1279, 1283 (Fed. Cir. 2000); *see also* Manual of Patent Examining Procedure, Section 2173.02. Conversely, if the language of the claim is such that a

person of ordinary skill in the art would not understand how infringement could be avoided, then a rejection under Section 112, second paragraph, would be appropriate. *See id.*; *see also Morton Int'l, Inc. v. Cardinal Chem. Co.*, 28 U.S.P.Q.2d 1190, 1195 (Fed. Cir. 1993).

While the Examiner noted that the word "pattern" had not been previously used in the specification, Applicants respectfully remind the Examiner that there is no requirement that Applicants use the exact same words in the claims as used in the specification. As noted above, the relevant test under 35 U.S.C. § 112, second paragraph, is whether the claim apprises one of ordinary skill in the art of its scope, thus providing clear warning to others as to what constitutes infringement of the patent. Patterns of light are notoriously well known in the art, and one skilled in the art would clearly understand how infringement of claim 42 could be avoided. As a result, claim 42 is believed to fully comply with the requirements of 35 U.S.C. § 112, second paragraph. Applicants respectfully request withdrawal of this rejection.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 19, 21-27, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Cutler (U.S. Patent No. 6,204,501). The Examiner also rejected claims 40, 42, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Scott et al. (U.S. Patent No. 3,576,563). Applicants respectfully traverse these rejections.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the

claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

Applicants respectfully submit that the Cutler reference fails to disclose each and every element of independent claim 19 and, therefore, fails to support a *prima facie* case of obviousness. For instance, independent claim 19 recites, among other things, a protective cover comprising “a first portion *of the cover*, the first portion being adapted to . . . *totally internally reflect the light* to the first surface region and the second surface region” (emphasis added). As discussed immediately below, the Cutler reference fails to disclose such an element.

The Cutler reference is generally directed to an improved radiation detector. Col. 1, lines 5-9; col. 1, lines 31-32. The cited reference is particularly concerned with coupling an external fiber to the detector. Col. 1, lines 42-45. Accordingly, the Cutler reference teaches a coupling arrangement for coupling an external fiber 10 to a detecting arrangement 12. Col. 1, lines 56-59. The coupling arrangement includes an annular member 18. Col. 2, lines 1-4. A protective sleeve 30, which houses a mid-infra red fiber 21, extends axially from the annular member 18. Col. 2, lines 4-8. Further, a tubular portion 24 extends from the protective sleeve 30. *See* col. 2, lines 8-11; FIGURE. The tubular portion 24 is a connecting element for connection with an SMA type connector 25 on the end of an external fiber 10. Col. 2, lines 8-11. This arrangement ensures alignment of fiber 10 and fiber 21 when connector 25 is plugged into tubular portion 24. Col. 2, lines 11-18.

The Examiner improperly compares a portion of annular member 18, tubular portion 24, and protective sleeve 30 to the “first portion of the cover” recited in independent claim 19. However, claim 19 clearly recites “a first portion of the cover, the first portion being adapted to . . . *totally internally reflect the light* to the first surface region and the second surface region” (emphasis added). In the Office Action, the Examiner

recognized that the cited reference fails to disclose the second portion of this limitation. Office Action mailed October 18, 2004, page 3. The Examiner attempted to obviate this acknowledged deficiency of the Cutler reference by suggesting that it is “notoriously well known” that fibers such as those illustrated in the FIGURE of the Cutler reference totally internally reflect light. *See id.*

Applicants respectfully note that the fact a fiber optic cable, such as fiber 10 or 21 of the Cutler reference, is capable of internally reflecting light is irrelevant in determining the patentability of the present claims. The present claim clearly indicates that it is a first portion *of the cover* that is adapted to totally internally reflect the light, not a first portion of a fiber optic cable, such as fibers 10 and 21 of the Cutler reference. After careful analysis of the cited reference, Applicants respectfully submit that the Cutler reference does not suggest that any of the elements 18, 24, or 30, which the Examiner equated to the recited cover, are capable of reflecting light at all, let alone adapted to “totally internally reflect the light” as is recited in independent claim 19. These elements 18, 24, and 30 are merely components of a coupling arrangement to permit coupling of fiber 10 to fiber 21. Further, Applicants also respectfully submit that neither of fibers 10 and 21 could be rationally equated to “a first portion of the cover” as recited in claim 19. Consequently, the Cutler reference fails to teach or suggest “a first portion of the cover, the first portion being adapted to . . . *totally internally reflect the light* to the first surface region and the second surface region” (emphasis added) as recited in independent claim 19.

Because the reference fails to disclose each and every element of the present claim, and because the Examiner failed to provide any rationale obviating the deficiencies of the reference, the Cutler reference cannot support a *prima facie* case of obviousness with respect to independent claim 19. Accordingly, Applicants respectfully submit that independent claim 19 is allowable over the Cutler reference. Furthermore, claims 21, 22, 24, 27, and 30 depend from independent claim 19. As a result, claims 21, 22, 24, 27, and 30 are believed to be allowable based not only on their dependency from an allowable

base claim, but also for the subject matter recited in each dependent claim. For these reasons, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 19, 21, 22, 24, 27, and 30.

Additionally, independent claim 23 similarly recites "a first portion *of the cover*, the first portion being adapted to . . . *totally internally reflect the light* to the first surface region and the second surface region" (emphasis added). Applicants reiterate that the Cutler reference fails to disclose any such element. As discussed above with respect to claim 19, none of the components of the Cutler apparatus that the Examiner compares to the presently recited cover (i.e. annular member 18, tubular portion 24, and protective sleeve 30) are capable of totally internally reflecting light. Further, as also discussed above, while fibers 10 and 21 may or may not be able to internally reflect light, these fibers cannot be reasonably be considered a portion of a cover. Thus, the Cutler reference similarly fails to support a *prima facie* case of obviousness. For these reasons, independent claim 23 is believed allowable over the Cutler reference. Applicants respectfully request withdrawal of the Examiner's rejection and allowance of independent claim 23.

Likewise, independent claim 25 also recites "a first portion *of the cover*, the first portion being adapted to . . . *totally internally reflect the light* to the first surface region and the second surface region" (emphasis added). As discussed above with respect to independent claims 19 and 23, the Cutler reference fails to disclose any such element. Further, the Examiner failed to otherwise account for this deficiency. Accordingly, independent claim 25 is believed allowable over the Cutler reference. Also, claim 26 depends from independent claim 25 and is also believed allowable based not only on its dependency from an allowable base claim, but also for the subject matter recited in the dependent claim. Consequently, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 25 and 26.

Turning now to the rejection of claims 40, 42, and 43, Applicants respectfully submit that the Scott et al. reference similarly fails to teach or suggest each element recited by independent claim 40, from which claims 42 and 43 depend. For example, the Scott et al. reference fails to disclose “adapting the electronic device . . . to refract the light at the *plurality of surface portions* so that the light is visible from a *plurality of sides of the enclosure*” (emphasis added) as recited in independent claim 40. In the Office Action, the Examiner acknowledged that the Scott et al. reference fails to teach this element. Office Action mailed October 18, 2004, page 7. In view of the deficiencies of the Scott et al. reference, the Examiner asserted that this element would have been obvious at the time of the invention. *Id.* However, as discussed below, the Examiner’s assertion does not overcome the deficiencies of the Scott et al. reference and, thus, a *prima facie* case of obviousness has not been established.

The Scott et al. reference is directed to an improved railroad signaling device. *See* col. 1, lines 6-8; col. 2, lines 63-64. Accordingly, the cited reference discloses a railroad signal 20 enclosed within a metal housing 32. *See* col. 4, lines 4-13; *see also* FIG. 2. The Scott et al. apparatus includes a single collimating lens 34 that directs light outwardly from the front of the apparatus. *See* col. 4, lines 14-18. The apparatus also includes a plurality of light bulbs, 54, 55, and 57, from which light is transmitted to the lens 34 via a light pipe or fiber optic bundle 56. Col. 4, lines 48-64; FIG. 2.

In the Office Action, the Examiner attempted to obviate the recognized deficiencies of the Scott et al. reference by asserting that this element “would have been obvious because it is notoriously well known that the lens 34 distributes light such that it is visible from a position below the lower side of such a light distributor and the light would also be visible directly in front of the enclosure.” Office Action mailed October 18, 2004, page 7. However, this assertion by the Examiner does not obviate the deficiencies of the Scott et al. reference. For example, independent claim 40 recites an electronic device adapted to “refract the light at the *plurality of surface portions*”

(emphasis added). The Examiner, in referring only to the Abstract and several of the figures of the Scott et al. reference, fails to point to any *plurality* of surface portions of the Scott et al. apparatus that refract light. Applicants respectfully note that the *only* surface portion of the Scott et al. apparatus capable of refracting light is the collimating lens 34, which only directs light from one side of the apparatus.

Further, the Examiner's suggestion regarding the visibility of light from a position below the apparatus does not obviate the deficiencies of the Scott et al. reference. While it is true that the light beam 102 emitted from the front of the Scott et al. apparatus may be such that it is visible from multiple angles with respect to the front of the apparatus, it does not follow that the light so emitted can be seen from the bottom of the apparatus. The light beam 102 extends from a vertical plane coextensive with lens 34. While the light beam 102 may vary in widths, the light beam 102, once emitted, cannot bend back toward the apparatus such that it is visible from the bottom, or any other portion, of the apparatus. Thus, the Scott et al. apparatus fails to suggest "that the light is visible from a *plurality of sides of the enclosure*" (emphasis added).

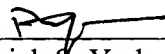
Because the Scott et al. reference fails to disclose each and every element of independent claim 40, and the Examiner failed to obviate the deficiencies of this reference, the Examiner failed to establish a *prima facie* case of obviousness. Accordingly, Applicants respectfully submit that independent claim 40 is allowable over the Scott et al. reference. Additionally, claims 42 and 43 each depend from independent claim 40. As a result, claims 42 and 43 are believed to be allowable based not only on their dependency from an allowable base claim, but also for the subject matter recited in each dependent claim. For these reasons, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 40, 42, and 43.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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